



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/965,356    11/06/97    BERNFIELD    M    CMCC533

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HM12/1130

EXAMINER

BAKER, A

ART UNIT

PAPER NUMBER

1632

DATE MAILED:

11/30/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Advisory Action

Application No.  
08/965,356

Applicant(s)  
Bernfield et al.

Examiner  
Anne-Marie Baker, Ph.D.

Group Art Unit  
1632



## THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☐ expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Oct 27, 1999 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

### ☒ The proposed amendment(s):

- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- ☒ will not be entered because:
- ☐ they raise new issues that would require further consideration and/or search. (See note below).
- ☒ they raise the issue of new matter. (See note below).
- ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: No support is found in the specification for the claim language reciting "proteoglycan portions thereof." The specification teaches how to make transgenic mice having a syndecan transgene, but does not contemplate making transgenic animals with "proteoglycan portions thereof."

- ☐ Applicant's response has overcome the following rejection(s):

- ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: \_\_\_\_\_

Claims objected to: \_\_\_\_\_

Claims rejected: 1-15

- ☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Other

*Deborah Crouch*  
DEBORAH CROUCH  
PRIMARY EXAMINER  
GROUP 1800/1630

Art Unit: 1632

### ADVISORY ACTION

The after final amendment filed on October 27, 1999 (Paper No. 14) has not been entered. The amendments to the claims do not place the claims in condition for allowance. Applicants arguments have been fully considered but are not deemed persuasive.

The 35 U.S.C. 112, first paragraph rejection of Claims 1-15 stands. Applicants argue that the specification is enabling for syndecan transgenic rats as well as syndecan transgenic mice. Applicants argue that the references cited by the Examiner to evidence unpredictability in the art of making transgenic animals of various species instead indicates that syndecan transgenic rats are enabled. Applicants arguments are directed to producing expression of a transgene in both rats and mice. However, Applicants have not addressed the issue raised with regard to obtaining sufficient expression of the transgene at the appropriate site to produce the desired phenotype. It is not enough to get expression of a transgene. The transgene must be expressed at a level sufficient to have an effect. The state of the art renders it unpredictable as to whether one skilled in the art could produce a transgenic rat or other rodent (with the exception of mice) expressing a sufficient amount of any syndecan to produce an obese phenotype. In the present case, undue experimentation would have been required to produce the claimed transgenic rodents.

The specification does not clearly define the "obese phenotype" recited in the claims. The specification clearly indicates that the mice of the invention exhibit maturity onset obesity. Limitation to transgenic mice exhibiting maturity onset obesity is therefore appropriate.

The specification does not provide support for the claimed syndecan transgenic rodents expressing a "proteoglycan portion thereof." The specification teaches how to make transgenic mice having a syndecan transgene, but does not contemplate making transgenic rodents with "proteoglycan portions thereof."

Art Unit: 1632

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne-Marie Baker whose telephone number is (703) 306-9155. The examiner can normally be reached Monday through Friday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasmine Chambers, can be reached on (703) 308-2035. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Anne-Marie Baker, Ph.D.